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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,560	04/26/2001	David Mallis	09432/168002	9436
22511	7590	11/19/2003	EXAMINER	
ROSENTHAL & OSHA L.L.P. 1221 MCKINNEY AVENUE SUITE 2800 HOUSTON, TX 77010			TUGBANG, ANTHONY D	
		ART UNIT	PAPER NUMBER	3729
DATE MAILED: 11/19/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/843,560	MALLIS, DAVID <i>U</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	A. Dexter Tugbang	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
  - 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/14/03 has been entered.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a threaded pipe connection, classified in class 285, subclass 93.
- II. Claim 23, drawn to a method of determining connection wear, classified in class 29, subclass 407.05.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II has separate utility such as rotationally engaging a pin member and box member and inspecting the connection. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. Newly submitted Claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth above.

Since applicant has received an action on the merits for the originally presented invention (Group I), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claim 23 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
7. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the phrase of “complimentary internal and external threads” (line 4) is unclear if this is referring to the previous phrases of “external threads” (line 2) and “internal threads” (line 3). How many groups of internal threads and external threads are there?

In Claim 10, the phrase of “the complimentary internal and external threads” (line 5) lacks positive antecedent basis. Furthermore, is this phrase referring to the previous recitations of “external threads” (line 3) and “internal threads” (line 4)?

Art Unit: 3729

In Claim 21, the phrase of “the other of the shoulder of the pin member and the shoulder of the box member” (lines 7-8) lacks positive antecedent basis.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Timme 4,438,953.

Regarding Claims 1, 10, 21 and 22, Timme discloses a method of manufacturing a wear indicator and a threaded pipe connection comprising: a pin member 11 (in Fig. 2) having external threads 15 increasing in width in one direction; a box member 35 (in Fig. 3) having internal threads 43 increasing in width in an opposite direction so that complementary internal threads and external threads move into engagement upon a make-up connection; and a wear indicator that extends from a shoulder (recess 23 and bevel 19) of the pin member 11 (see Fig. 4) where the connection wear is indicated by the contact between the wear indicator 17 and a shoulder 39 of the box member 35 (see col. 2, lines 60-66).

Regarding Claims 2-9 and 11-18, the shoulder of the pin member 11 can be read alternatively as either an “internal shoulder” or an “external shoulder”; and the shoulder 39 of the box member 35 can be read alternatively as an “internal shoulder” or an “external shoulder”. When the pin member 11 and the box member 35 form the make-up connection, the wear

Art Unit: 3729

indicator 17 can be said to be disposed on or extending from both the external or internal shoulders of either the pin member and the box member.

Regarding Claim 19, the means-plus-function language of a “means for indicating connection wear” is read as the structure of the wear indicator 17 in Timme.

Regarding Claim 20, the wear indicator 17 of Timme is considered to be a circumferential extension from the body 13 (see Fig. 4).

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-22 (in Paper No. 11) have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

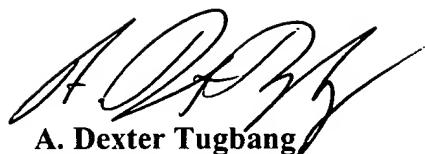
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Application/Control Number: 09/843,560  
Art Unit: 3729

Page 6



A. Dexter Tugbang  
Primary Examiner  
Art Unit 3729

November 12, 2003